



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,458	12/19/2000	Christopher L. Wong	23047-701	8837

22830 7590 01/07/2005

CARR & FERRELL LLP
2200 GENG ROAD
PALO ALTO, CA 94303

EXAMINER

COLON, CATHERINE M

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,458

Applicant(s)

WONG ET AL.

Examiner

C. Michelle Colon

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37, 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37, 39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Final Office Action in response to the communication received on October 13, 2004. Claims 3, 14 and 37 have been amended. Claim 38 has been cancelled. Claims 1-37, 39 and 40 are now pending in this application.

Response to Amendment

2. Applicant's amendments to claims 3, 14 and 37 are acknowledged. The amendments to claims 3 and 14 are sufficient to overcome the claim objections set forth in the previous Office Action. Therefore, the claim objections of claims 3 and 14 set forth in the previous Office Action are withdrawn.

Response to Arguments

3. Applicant's arguments have been fully considered, but are found unpersuasive. In the Remarks, Applicant argues the following: 1) that Wright does not teach tracking expenditures for a *project already underway*; 2) that Wright does not teach collecting information about the activity of an individual contractor; 3) that Wright does not teach a purchase order function for generating a purchase order in response to an approved work order; 4) that Wright does not teach a risk management function for monitoring compliance with government rules and regulations; 5) that Wright does not teach hours worked, type of work done and comments regarding work done; and 6) that Wright does not teach maintaining a work journal for the at least one contractor, including automatically updating work journal, using data input by the at least one contractor and

at least one supervisor of the at least one contractor regarding job performance of the at least one contractor.

In response to argument 1), Examiner respectfully disagrees. To begin with, nothing in claim 1 expressly recites tracking expenditures for a project *already underway*. Therefore, applying a broadest reasonable interpretation with a reference such as Wright that estimates expenditures for an upcoming project suffices. In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). If Applicant believes the distinction between a *current project already underway* versus an *upcoming project* is an important one, it is suggested that the claims be amended to explicitly indicate the type of project (i.e., current or future) being claimed.

In response to argument 2), Examiner respectfully disagrees. As discussed above, nothing in claim 1 indicates that the project being claimed is a current project already underway. Therefore, since Wright discloses a system through which contractors can post information about themselves such as their job experiences and work capabilities in order to be considered for a project, such information can be considered the "activity" of the contractor. Examiner also notes that nothing in the claims expressly recites what is meant by the "activity" of a contractor. Since the term, activity, is so broad, any broadest reasonable interpretation is acceptable.

In response to argument 3), Examiner respectfully disagrees. As discussed in the Office Action, owners or project managers define a project's specifications and accept a bid for work on the project, where the bid may include the purchase of services and/or equipment from a contractor/vendor. Thus, since the project specification is defined when bids are submitted, the project specification acts as a work order. When a bid is selected and approved, it acts as a purchase order for the services/equipment outlined in the bid for the project (col. 4, lines 39-42 and 54-59; col. 5, line 65-col. 6, line 2; col. 9, line 67-col. 10, line 2). Additionally, Examiner notes that Applicant does not pose any substantive arguments for argument 3), other than merely stating he fails to see how Wright teaches a purchase order function for generating a purchase order in response to an approved work order. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In response to argument 4), Examiner respectfully disagrees. In col. 1, lines 28-30; and col. 4, lines 20-31, Wright discloses that a project owner can be a government entity that has certain functional specification requirements. Wright also discloses a system that facilitates a screening process where vendors/contractors can include their qualifications and capabilities and project owners can view the information (col. 4, lines 48-53). Additionally, Examiner notes that Applicant does not pose any substantive arguments for argument 4), other than merely stating he fails to see how Wright teaches a risk management function for monitoring compliance with government rules and

regulations. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In response to arguments 5) and 6), Examiner respectfully disagrees. In col. 10, lines 26-36 and 43-48; col. 11, lines 43-48; col. 12, lines 13-20, Wright discloses a system that allows contractors/vendors to be considered for projects by project owners through posting information about their qualifications and capabilities such as past projects completed, the type of work they've done, recommendations from past projects, the size of projects capable of handling, etc. Based on Applicant's arguments, it is clear that "work done" means work completed for a project *currently underway* and not for a future project as taught by Wright. However, since the claims do not expressly define the status (i.e., current or future) of the project, an amendment to the claims to clarify the status is suggested.

Therefore, Applicant's arguments have been fully considered, but found unpersuasive. Claims 1-37, 39 and 40 remain rejected.

Claim Objections

4. Claim 39 is objected to because of the following informalities: Since claim 38 has been cancelled, claim 39 cannot depend from it. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-13, 15-31, 33-37 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Wright et al. (U.S. 6,581,040).

As per claims 1 and 19, Wright et al. discloses a method and system for workforce procurement and management using a hosted network application, the method comprising:

maintaining a plurality of modules accessible at varying levels to different participants in a workforce procurement and management process, the modules comprising (col. 7, lines 19-37; Figures 3-6; The system discloses a workforce procurement system with multiple modules providing different levels of access to different individuals participating in the system.),

an exchange module comprising a search function (col. 4, lines 40-59; col. 5, lines 28-44; The system provides a filtering and matching feature that allows participants to search for the project and/or resource that is best suited for them.);

a skills fulfillment module comprising,

a skills requirement function for specifying skills required for a project (col. 6, lines 6-16; col. 9, lines 9-25; Project managers enter various project requirements such as resource capabilities (i.e., skills).); and

a settlement function for tracking expenditures on a project (col. 2, lines 22-24; col. 9, lines 46-53; The system discloses tracking expenditures on a project in order for a resource provider to formulate a quote for the project.);

resource management module comprising a work journal function for collecting information about the activity of an individual contractor (col. 10, lines 26-36 and 43-48; col. 12, lines 13-20; The system collects and maintains information on resource providers (i.e., contractors, vendors, etc. and their skills and experiences).);

a knowledge management module comprising a reporting function and an analysis function (col. 5, lines 17-20; The system allows project managers to report changes to project specifications.); and

maintaining a database coupled to the plurality of modules (abstract; col. 4, lines 20-21 and 32-38).

As per claims 2 and 20, Wright et al. discloses the method and system of claims 1 and 19, wherein the exchange module further comprises:

a sourcing function for specifying sourcing preference and rules for a project and a transaction management function for managing a hiring process including sourcing, interviewing, and negotiation (col. 4, lines 39-42; col. 6, lines 6-16; col. 9, lines 9-25).

As per claims 3 and 21, Wright et al. discloses the method and system of claims 1 and 19, wherein the skills fulfillment module further comprises:

a request for proposal (RFP) function for entering an RFP (col. 6, lines 31-48; col. 9, lines 9-53; Figure 3);

a work order function for documenting terms and conditions of a project and a purchase order function for generating a purchase order in response to an approved work order (col. 4, lines 39-42 and 54-59; col. 9, line 67-col. 10, line 2; Owners or project managers define the project specifications and accept a bid for work on the project. Thus, since the project specification is already defined when bids are submitted, the project specification acts as a work order when a bid for work is selected.);

a logistics management function for facilitating the logistical components of a hiring process including management of blood testing, badging, and facilities (col. 5, line 65-col. 6, line 2; col. 10, lines 50-55);

a fulfillment management function for managing the fulfillment of sourcing requirements, including maintaining a status of sourcing requirements (col. 6, lines 38-48);

a risk management function for facilitating the pre-qualification of a contractor and a consultant and for monitoring compliance with government rules and regulations (col. 1, lines 28-31; col. 2, line 64-col. 3, line 4; col. 3, lines 57-64; col. 4, lines 20-31 and 56-59).

As per claims 4 and 22, Wright et al. discloses the method and system of claims 1 and 19, wherein the resource management module further comprises an expense reporting function (col. 2, lines 22-24; col. 9, lines 46-53).

As per claims 5 and 23, Wright et al. discloses the method and system of claims 1 and 19, wherein the plurality of modules further comprises:

a supply management module comprising a supplier network function and a digital portfolio function, a supplier workbench module comprising a supplier workbench function (col. 5, line 56-col. 6, line 30; The system provides suppliers with templates to communicate via the network.); and

a common functions module comprising: an administration function, a workflow function, a catalog function and an agreements function (col. 9, line 46-col. 10, line 25; Figures 4 and 5; The system comprises various functions for all parties to communicate and interact within the project management system.).

As per claims 6 and 24, Wright et al. discloses the method and system of claims 1 and 19, wherein the different participants include a contractor who is an individual contingent worker, a client who is an employee of an enterprise, a recruiter who sells a service of finding contingent workers, and a staffing supplier who sells a service of finding contingent workers, including finding multiple contingent workers to staff a project (col. 5, line 56-col. 6, line 2).

As per claims 7 and 25, Wright et al. discloses the method and system of claims 6 and 24, wherein the participant includes a contractor, a staffing supplier, and a recruiter, and wherein the predetermined criteria includes a list of staffing suppliers, and a list of skills, and wherein the predetermined criteria are generated by the analysis function (col. 4, lines 39-53; col. 5, line 56-col. 6, line 2; col. 7, lines 29-60; col. 11, lines 25-48; Participants are project owners, contractors and suppliers. The system

maintains certain criteria on all participants such as project owners' requirements and contractors' and suppliers' skills and capabilities.).

As per claims 8 and 26, Wright et al. discloses the method and system of claims 7 and 25, wherein the different participants have varying levels of access to the hosted network application based upon attributes, wherein attributes include personal attributes associated with a participant, and enterprise attributes associated with an enterprise using the hosted network application (col. 5, line 56-col. 6, line 2; col. 8, line 60-col. 9, line 8; Figure 3; Participants have varying levels of access to the network.).

As per claims 9 and 27, Wright et al. discloses the method and system of claims 1 and 19, wherein the work journal function comprises:

the contractor entering data into a work journal data entity, wherein the entered data comprises, hours worked, type of work done and comments regarding work done (col. 10, lines 26-36 and 43-48; col. 11, lines 43-48; col. 12, lines 13-20; The system collects and maintains information on resource providers (i.e., contractors, vendors, etc. and their skills and experiences).);

a client who is a manager reviewing the work journal data entity, the manager approving the work journal data entity and the manager entering comments into the work journal data entity (col. 4, lines 54-59; Project owners can review the work of resource providers.).

As per claims 10 and 28, Wright et al. discloses the method and system of claims 5 and 23, wherein the digital portfolio function comprises:

populating a digital portfolio data entity with data extracted from an electronic resume, populating the digital portfolio data entity with data from systems external to the hosted network application and automatically updating the digital portfolio data entity with data from the work journal data entity (col. 10, line 26-col. 11, line 24; col. 12, lines 24; The system allows resource providers to create digital portfolios on their work experience and capabilities. Resource providers can populate and update their portfolios using the templates.).

As per claims 11 and 29, Wright et al. discloses the method and system of claims 1 and 19, wherein the search function comprises;

performing a search for a contractor based upon predetermined criteria entered by a participant, performing a search for a contingent position based upon predetermined search criteria entered by the participant, searching the database, including searching a plurality of digital portfolio data entities and searching a plurality of public databases that are not part of the hosted application (col. 4, lines 40-59; col. 5, lines 28-44; The system provides a filtering and matching feature that allows participants to search for the project and/or resource that is best suited for them.).

As per claims 12 and 30, Wright et al. discloses the method and system of claims 3 and 21, wherein the work order function comprises;

a participant generating a work order based upon a successful search for a contractor, at least one participant reviewing the work order at least one level in order to determine whether to approve the work order, if the work order is not approved, returning the work order to a level below the level at which it was not approved and

collecting data regarding the work order, approval, and failure to approve in the database, wherein the knowledge management module accesses the collected data (col. 4, lines 39-42 and 54-59; col. 9, line 67-col. 10, line 2; Owners or project managers define the project specifications and accept/approve a bid for work on the project. Thus, since the project specification is already defined when bids are submitted, the project specification acts as a work order when a bid for work is selected. The system collects the data on the bids submitted for a project.).

As per claims 13 and 31, Wright et al. discloses the method and system of claims 12 and 30, wherein the work order function further comprises associating a purchase order with the work order when the work order is approved (col. 4, lines 39-42 and 54-59; col. 9, line 67-col. 10, line 2; Owners or project managers define the project specifications and accept a bid for work on the project. Thus, since the project specification is already defined when bids are submitted, the project specification acts as a work order when a bid for work is selected.).

As per claims 15 and 33, Wright et al. discloses the method and system of claims 3 and 21, wherein the request for proposal function comprises receiving a request for proposal including a list of required contingent workers and their associated skills, linking the request for proposal with a project specification that includes data regarding a project to be staffed, generating a search based upon the request for proposal and the project specification, wherein the search uses the exchange module, broadcasting at least part of the request for proposal to publicly accessible applications, receiving responses to the request for proposal, conducting bargaining based upon responses to

the request for proposal including auctions and reverse auctions (col. 4, lines 39-53; col. 5, line 56-col. 6, line 2; col. 7, lines 29-60; col. 10, line 26-col. 11, line 48; The system maintains criteria on all participants of the system such as project owners' requirements and contractors' and suppliers' skills and capabilities. Participants search and view information via the exchange module on the web site.).

As per claims 16 and 34, Wright et al. discloses the method and system of claims 1 and 19, wherein the reporting function comprises generating at least one report using data including data generated by the plurality of modules and stored in the database (col. 5, lines 17-20; The system allows project managers to report changes to project specifications.).

As per claims 17 and 35, Wright et al. discloses the method and system of claims 1 and 19, wherein the analysis function comprises:

automatically performing an analysis of at least one report based upon criteria selected by a participant and the participant changing at least one attribute based upon a review of the analysis (col. 5, lines 17-27; The system allows project managers to report changes to project specifications.).

As per claims 18 and 36, Wright et al. discloses the method and system of claims 1 and 19, wherein the hosted network application is hosted on the Internet (col. 10, line 56-col. 11, line 10).

As per claim 37, Wright et al. discloses an electromagnetic medium containing executable instructions which, when executed in a processing system, cause the

Art Unit: 3623

system to perform workforce management, wherein performing workforce procurement comprises:

receiving a staffing requirement for a project (col. 6, lines 6-16; col. 9, lines 9-25; Project managers enter various project requirements such as resource capabilities (i.e., skills).);

searching a database of digital portfolios to find at least one suitable contractor for the project (col. 4, lines 40-59; col. 5, lines 28-44; The system provides a filtering and matching feature that allows participants to search for the project and/or resource that is best suited for them);

filling the staffing requirement with the at least one contractor (col. 4, lines 39-42 and 54-59; col. 9, line 67-col. 10, line 2; Owners or project managers fill project staffing requirements by accepting bids by contractors to work on the project.); and

automatically updating a digital portfolio of the at least one contractor using data entered by the at least one contractor and at least one supervisor of the at least one contractor (col. 10, line 26-col. 11, line 24; col. 12, lines 24; The system allows resource providers to create digital portfolios on their work experience and capabilities. Resource providers can populate and update their portfolios using the templates.);

maintaining a work journal for the at least one contractor, including automatically updating work journal, using data input by the at least one contractor and at least one supervisor of the at least one contractor regarding job performance of the at least one contractor (col. 10, lines 26-36 and 43-48; col. 11, lines 43-48; col. 12, lines 13-20; The

system collects and maintains information on resource providers (i.e., contractors, vendors, etc. and their skills and work experiences).

As per claim 40, Wright et al. discloses the electromagnetic medium of claim 39, wherein performing workforce management further comprises generating reports regarding the project using data from the work journal (col. 5, lines 17-27; The system allows project managers to report changes to project specifications, which impacts the work performed by the resource providers.).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14, 32 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al. (U.S. 6,581,040) as applied above.

As per claims 14, 32 and 39, Wright et al. discloses the method, system and electromagnetic medium of claims 1, 19 and 38, wherein the settlement function comprises submitting the approved work journal of a contractor to a staffing supplier associated with the contractor and storing data regarding the settlement function in the database, wherein the knowledge management module accesses the stored data (col. 10, lines 26-36 and 43-48; col. 12, lines 13-20; The system collects and maintains information on resource providers (i.e., contractors, vendors, etc. and their skills and

experiences).). Wright et al. does not expressly disclose generating an invoice or submitting the invoice to the manager for approval. However, it is old and well in the art of project management that when work is done by third parties, the third parties charge for their completed work via invoices. Thus, at the time of the invention it would have been obvious to a person of ordinary skill in the art in the system of Wright et al. for the resource providers to generate invoices after their work on the project is completed (and approved) because doing so is an old and well known process in the industry and doing so also enables the resource provider to get paid for their services rendered.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 703-605-4251. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 703-305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

703-872-9306	[Official Communications; including After Final communications labeled "Box AF"]
703-746-7202	[For status inquiries, draft communication, labeled "Proposed" or "Draft"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA 7th floor receptionist.


cmc
January 3, 2005


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600